

particular to claim 129 only. The Examiner does not cite or address any of the elements recited by claims 8–50 and 130–148, and has, therefore, failed to substantively examine claims 8–50 and 130–148 on the merits of each individual claim. *See*, Office Action at Pages 4–5. With respect to claims 8–50 and 130–148, the Examiner opines that “some of the claims recite the same limitations, accordingly, the Examiner encompasses the rejection of all the claims that recite the same limitations” (Page 6). However, the Examiner fails to identify **any** similarities between the elements recited in the 7 examined claims, i.e., claims 1, 2, 3, 5–7 and 129, and the elements recited in the 62 unexamined claims, i.e., claims 8–50 and 130–148. Without this identification, the Applicants can not substantively respond to the Examiner’s rejection.

Consequently, the Applicants request that the Examiner withdraw the outstanding Office Action and issue a new Office Action in which each of the elements of claims 8–50 and 130–148 are substantively examined, or, in the alternative, a Notice of Allowance. *See*, MPEP § 707.07, “Completeness and Clarity of Examiner’s Action;” MPEP § 707.07(g), “Piecemeal Examination.”

Similarly, in the immediately preceding Office Action mailed August 21, 2002, claims 8–50 and 129–148 were not substantively examined on the merits of each individual claim. The Applicants’ representative noted this deficiency to the Examiner during the telephone interview conducted on September 3, 2002, as well as in the Response filed on November 21, 2002. While many examples of the differences between the 7 examined claims (i.e., claims 1, 2, 3, 5–7 and 129) and the 62 unexamined claims (i.e., claims 8–50 and 130–148) may be described, two examples are identified below.

In the first example, claim 8 recites, in pertinent part, “a **translator** for reading and writing files in the native language of the NCD software, and read and write files in the native language of the client software.” This feature is not recited in claims 1, 2, 3, 5–7 or 129; consequently, the Examiner has failed to address this element in the pending Office Action. Moreover, the Applicants submit that Clark is entirely silent on whether a network communications device may include a translator.

In the second example, claim 130 recites, in pertinent part, “**receiving the offer and data file** from the data recipient computer,” “**processing the data file**,” “**creating the message**,” and “**sending the offer and the message** to the data repository.” These features are not recited in claims 1, 2, 3, 5–7 or 129; consequently, the Examiner has failed to address these elements in the pending Office Action. Moreover, the Applicants submit that

Clark is entirely silent on whether an offer and data file may be received at a network communications device, or whether the data file may be processed. Furthermore, Clark fails to disclose that a message may be created, or that the offer and message may be sent from the network communications device to a data repository (*See also*, remarks directed to claim 129 below).

### **Claims 1–50 Are Allowable Over the Cited Art**

Clark is directed to a system for delivering financial services to different geographical locations and time zones, and includes a global interface device (GID) 10, one or more customer facilities (CF) 12, a global telecommunications network (GTN) 13, and a plurality of on-line transaction processors (OLTP) 14. *See*, e.g., Abstract; FIG. 1; Col. 3, lines 5–14; Col. 4, lines 50–60; Col. 29, lines 2–30. The Applicants respectfully submit that Clark fails to disclose many features of the claimed invention.

Claim 1 is directed to a system for data recipient invoked electronic transactions, and recites, in pertinent part, a "data recipient computer having web server software for hosting a web page." The Examiner cites to the Abstract and FIG. 1 to support the § 102 rejection. *See*, Office Action at Page 3. However, the Applicant submits that Clark is entirely silent on whether his system includes a computer having web server software for hosting a web page. Moreover, Clark fails to teach or suggest the use of any protocols associated with web server software, such as, e.g., HTTP, HTML, XML, WML, etc. Rather, Clark discloses a "specially developed software package" that includes various software applications, none of which suggest the use of web page hosting software. *See*, e.g., Col. 18, lines 22–34; FIGS. 15, 17, 20, 23, 24, 28, etc.

The Examiner opines that "HTML, XML and WML are notoriously well-known in the art" and takes Official Notice of that fact (Page 5). However, in order to combine Clark's "specially developed software package" with the well-known protocols of HTTP, HTML, XML, WML, etc., the Examiner must identify some teaching or suggestion in Clark that would provide the required motivation for one skilled in the art to arrive at this combination.

In establishing obviousness, the Office has the burden of pointing to some suggestion or motivation to combine teaching the references. While a reference can be utilized for all that it teaches, focusing on isolated portions of the reference or picking and choosing only that which supports a holding of obviousness is improper. *See*, e.g., *Panduit Corp. v. Dennison Mfg. Co.*,

1U.S.P.Q.2d 1593, 1602 (Fed. Cir. 1987). Moreover, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *See, e.g., Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

The Applicants respectfully submit that Clark provides no such suggestion, and, furthermore, that Clark is entirely silent on whether his system may be modified to include the use of Internet-based, web server software, web pages, etc., or any of the related protocols noted above.

Claim 1 also recites, in pertinent part, at least one data recipient computer having client software that includes **"instructions for forwarding a data recipient's offer to the at least one data repository via the gateway computer, the second network, and the NCD software."** The Examiner cites to FIG. 15, Col. 20, lines 65–67, Col. 21, lines 1–60 and Col. 14, lines 14–21 to support the § 102 rejection. *See*, Office Action at Page 3. The Applicants respectfully disagree. Clark discloses that his electronic delivery system operates under a specially developed software package installed on a workstation, and the Applicants submit that Clark fails to teach or suggest the claimed "instructions for forwarding a data recipient's offer to the at least one data repository via the gateway computer, the second network, and the NCD software". *See, e.g.*, Col. 18, lines 22–64; Application at Page 9 line 18 to Page 10 line 1, etc.

Moreover, Clark fails to disclose the use of a **"data recipient's offer"** within his global financial services system. Clark discloses a securities application that allows the user to "create, verify, authorize, view affirmations and view all securities transactions" (Col. 20, line 66 to Col. 21, line 1). *See also*, Col. 21 lines 2–60. However, as described within the Specification, "the present invention allows data subject 100 to purchase a product or service (hereinafter an "item") over common network 160 and allows data recipient 104 to receive payment information relating to the transaction" (Page 9, lines 13–15). Accordingly, an "offer" in the context of the present invention is a proposal to purchase the item, as in "something, such as a suggestion, proposal, or bid, that is offered" (*The American Heritage Oxford Dictionary, Third Edition*, Houghton Mifflin Company, 1997, Page 947). Consequently, the Applicants respectfully submit that Clark fails to disclose a "data recipient's offer," as well as "instructions for forwarding a data recipient's offer ..., " as recited by claim 1.

Accordingly, claim 1 is allowable over the cited art. Claims 2–50, depending from claim 1, are also allowable at least for the reasons discussed above.

### **Claims 129–148 Are Allowable Over the Cited Art**

Claim 129 is directed to a method for purchasing an item over a first network coupled to a second network by a gateway, and recites, in pertinent part, “**receiving a request for an offer from a data subject**” and “**sending the offer and a data file from the data recipient computer to the data subject**” at a data recipient. The Examiner cites the Abstract and FIG. 1 to support the § 102 rejection. *See*, Office Action at Page 4. The Applicants respectfully disagree, and submit that Clark is entirely silent on whether a request for an offer may be received by any element of his system. The Abstract does include the word “*requested*,” but it is used in an entirely different context, i.e., “A system for communicating with a global electronic delivery system that integrates a plurality of financial services provided at different geographical locations and in different time zones, and delivery [sic] such services directly to a customer facility at any time *requested* by the customer.” Furthermore, Clark also fails to disclose that an offer and a data file may be sent to any element of his system.

Claim 129 also recites, in pertinent part, “**receiving the offer and a message from the data subject**” and “**presenting the offer to the data subject**” at a data repository. The Examiner cites FIG. 15, Col. 20, lines 65–67, Col. 21, lines 1–60 and Col. 14, lines 14–21 to support the § 102 rejection. *See*, Office Action at Pages 4–5. The Applicants respectfully disagree, and submit that Clark is entirely silent on whether an offer and a message may be received by any element of his system. Furthermore, Clark also fails to disclose that the offer may be presented to the data subject.

Consequently, claim 129 is allowable over the cited art. Claims 130–139, depending from claim 129, are also allowable, at least for the reasons discussed above. Claim 140 is directed to a system for conducting electronic transactions, and recites elements comparable to claim 129. Consequently, claim 140 is also allowable over the cited art. Claims 141–148, depending from claim 140, are allowable as well, at least for the reasons discussed above.

Accordingly, the Applicants respectfully request that the Examiner reconsider and withdraw the pending § 102 and § 103 rejections.

## CONCLUSION

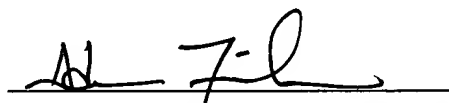
In view of the remarks submitted above, the Applicants respectfully submit that the present case is in condition for allowance. A notice to that effect would be greatly appreciated.

The Examiner is invited to contact the undersigned at (202) 220-4294 to discuss any matter concerning this application.

The Office is authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

A handwritten signature in black ink, appearing to read 'A. Treiber', is written over a horizontal line.

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